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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/731,874	12/09/2003	Ruben F. Lah	9312.52	6740

21999 7590 06/28/2005
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EXAMINER

DOROSHENK, ALEXA A

ART UNIT PAPER NUMBER

1764

DATE MAILED: 06/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/731,874

Applicant(s)

LAH, RUBEN F.

Examiner

Alexa A. Doroshenk

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 April 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) _____ is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-58 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Double Patenting

1. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 1-58 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 39-96 of copending Application No. 10/997,834. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Response to Arguments

Specification

The objection to the specification is withdrawn due to applicant's amendments to the abstract.

Double Patenting

Applicant's assertion that the 35 USC 101 statutory type double patenting is not appropriate because the "claim wording is not identical between the copending applications" is not persuasive.

This rejection is based on a "same invention" not "identical wording". Even so, the only claims which differ by any words at all are that of instant claim 1 and claim 39

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of the '834 application. The instant claim recites a valve closure being actuated to "oscillate between and open and closed position" and the '834 claim 39 recites this as "travel between an open and closed position". In this instance, oscillating from open to closed, as claimed, and traveling between open and closed are identical movements and therefore drawn to the same invention. Additionally, the specification of the '834 application only discloses the "travel" movement as oscillation.

The following is a list of the instant claims and the corresponding claims in '834 for applicant to review:

Claims of 10/731,874		Claims of 10/997,834
1	equivalent to	39
2	identical to	40
3	identical to	41
4	identical to	42
5	identical to	43
6	identical to	44
7	identical to	45
8	identical to	46
9	identical to	47
10	identical to	48
11	identical to	49
12	identical to	50
13	identical to	51
14	identical to	52
15	identical to	53
16	identical to	54
17	identical to	55
18	identical to	56
19	identical to	57
20	identical to	58
21	identical to	59
22	identical to	60
23	identical to	61
24	identical to	62
25	identical to	63
26	identical to	64

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27	identical to	65
28	identical to	66
29	identical to	67
30	identical to	68
31	identical to	69
32	identical to	70
33	identical to	71
34	identical to	72
35	identical to	73
36	identical to	74
37	identical to	75
38	identical to	76
39	identical to	77
40	identical to	78
41	identical to	79
42	identical to	80
43	identical to	81
44	identical to	82
45	identical to	83
46	identical to	84
47	identical to	85
48	identical to	86
49	identical to	87
50	identical to	88
51	identical to	89
52	identical to	90
53	identical to	91
54	identical to	92
55	identical to	93
56	identical to	94
57	identical to	95
58	identical to	96

The rejection is maintained and the terminal disclaimer filed by applicant does not overcome the rejection.

Conclusion

2. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alexa A. Doroshenk whose telephone number is 571-272-1446. The examiner can normally be reached on Monday - Thursday from 9:00 AM - 7:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Caldarola can be reached on 571-272-1444. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Alexa A. Doroshenk
Examiner
Art Unit 1764

June 22, 2005



**ALEXA DOROSHENK
PRIMARY EXAMINER**